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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,953	09/17/2001	Junzo Sunamoto	Yanagihara Case 62	4435
7590 05/04/2005			EXAMINER	
Flynn Thiel Boutell & Tanis 2026 Rambling Road Kalamazoo, MI 49008-1699			WILLIAMS, LEONARD M	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/936,953	Applicant(s) SUNAMOTO ET AL.	
	Examiner Leonard M. Williams	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,5 and 8-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,5 and 8-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Examiner note receipt of the Response to the Office Action dated July 1, 2004, amending claim 1 and adding new claims 10-12. Claims 1, 4, 5, and 8-12 are currently pending. Claims 2-3 and 6-7 are cancelled.

Response to Arguments

Applicant's arguments and amendments to the claims, see pages 2-5 of applicants Response to the Office Action dated July 1, 2004, filed January 03, 2005, with respect to the rejection(s) of claim(s) 1, 4, 5, 8, and 9 under 102(b) have been fully considered and are persuasive in view of the amendment to the claims. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Sunamoto et al. (English Translation of JP 03-292301) in view of Ishiwatari et al. (US Patent No. 6074652).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 4-5, and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunamoto et al. (English Translation of JP 03-292301) in view of Ishiwatari et al. (US Patent No. 6074652).

Sunamoto et al. disclose polysaccharide-sterol derivatives. Exemplified is an emulsion comprising 10mg oil (glycerol tricaprylate, a cosmetic component), 5mg pullulan-cholesterol derivative, and 1mL water (a cosmetic component), a percent weight of 0.5% pullulan cholesterol derivative and 95.5% cosmetic components (oil and water), see page 14. For the pullulan-cholesterol derivative having the structure of

formula (1) of the instant claims, see page 2, claim 1. For 0.1-6 units per 100 monosaccharide units, see page 2, claim 1.

It is respectfully pointed out that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Thus, the intended uses of claims 8 and 9 are not afforded patentable weight.

It is further respectfully pointed out that the recitation "cosmetic" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Sunamoto et al. does not teach a solvent containing at least one of a volatile oil and a volatile solvent or wherein said cosmetic components additionally comprise at least one member selected from moisture-preserving agents, UV absorbers, beauty whitening agents, inorganic pigments etc...or wherein the solvent comprises a volatile hydrocarbon oil having a boiling point at normal pressure in the range from 60-160°C.

Ishiwatari et al. teach, in col. 1 line 40 to col. 2 line 45, an oil-in-water emulsified composition which has good usability and stability comprising an α -monoalkyl glyceryl ether, a wax, and a silicone oil, and can contain a higher alcohol, a water-soluble high polymer, an humectant, and a UV-protecting agent and film forming agent.

Ishiwatari et al. teach, in col. 5 lines 5-10, the preferred silicone oils can be volatile or non-volatile, straight chain or cyclic, and with specific embodiments being dimethylpolysiloxane, decamethylcyclopentasiloxane, and methylphenylpolysiloxane.

Ishiwatari et al. teach, in col. 10 lines 55-67, that the oil-in-water emulsified composition can be stabilized by addition of water-soluble high polymers such as polysaccharides.

Ishiwatari et al. teach, in col. 11 lines 15-35, that the oil-in-water emulsified compositions are to be used in the formulation of cosmetic products. In example 1-1 a cosmetic cream formulation is presented comprising a water phase and an oil phase. In the oil phase octamethylcyclotetrasiloxane (30% by weight) and dimethylpolysiloxane (3% by weight) are present. The examiner notes that both of these siloxanes meet the applicant's examples of a volatile solvent and a volatile oil having a boiling point between 60-160°C. Additionally the water phase contain the humectants malitol and glycerin (moisture-preserving agents).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the pullulan-sterol compositions of Sunamoto et al. in the cosmetic water-in-oil emulsions of Ishiwatari et al. as pullulan-sterol compositions had previously been used in the formulation of emulsions (and liposomes) and that the

pullulan-sterol emulsions exhibited improved chemical and physical stabilities. One would have been motivated to use the pullulan-sterol compounds in the Ishiwatari et al cosmetic emulsions in order to take advantage of the improved chemical and physical stability exhibited by the pullulan-sterol compounds.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leonard M Williams whose telephone number is 571-272-0685. The examiner can normally be reached on MF 9-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LMW


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER